

REMARKS

Claims 8-17 are pending in the application. Claims 16 and 17 stand rejected as being directed to nonstatutory subject matter. Claims 8-17 stand rejected as being unpatentable over U.S. Patent No. 4,674,044 to Kalmus et al. (KALMUS).

This request amends Claims 16 and 17 to overcome the rejection under 35 USC 101, argues that the OA does not state a *prima facie* case of unpatentability with regard to KALMUS, and adds Claims 18-27 directed to same invention.

Regarding Rejection of Claims 16-17 as Unpatentable Under 35 USC §101

The test asserted by the OA is improper. However, Claims 16 and 17 are amended to overcome the rejection as stated. The OA notes that:

The invention in the body of the claim must recite technology.

Claims 16 and 17 now recite that the method is performed *in a computer system*.

Regarding Rejection of Claims 16-17 as Unpatentable over KALMUS Under 35 USC §103

After broadly restating language used across Claims 8-17, the OA asserts:

Kalmus uses different words to describe the applicant's invention. 3. Kalmus taught, in 1985 a generic method and system for a computer automated securities trading system which was specifically designed to execute all the functions and features described in claims 8-17.

This is the complete text of the OA regarding how KALMUS applies to the language of the invention as claimed. The OA does not apply the reference to the claims other than by simply **declaring** that the reference discloses the elements. This rejection does not address (as required for a *prima facie* case of obviousness) how the reference teaches or suggests all elements of the claims. The OA admits that the reference “uses different words to describe

the applicant's invention" but neglects to indicate how the words from the reference relate to the words used in the claims. A *pro forma* recitation of elements along with a assertion that all elements are found in the reference is insufficient to meet the requirement that the reference(s) teach or suggest all elements of the claim – especially in light of the admission that the reference uses different words.

The OA then declares KALMUS "pioneering":

Because it was a pioneering invention it would have been obvious to one skilled in the art to have been fully aware of Kalmus' teachings and to have used his invention to practice applicant's invention prior to applicant's filing date.

It is not a sufficient test for obviousness that one skilled in the art would have simply "been fully aware of" teachings of a patent declared pioneering by an Examiner. The undersigned hereby challenges the assertion that KALMUS is "pioneering," and further notes that the tests for patentability confer no legal status on pioneering inventions.

The OA goes on to put the Applicant on notice regarding Official Notice. No official notice appears to have been taken in this case.

For these reasons, the undersigned respectfully requests that the rejection be withdrawn.

CONCLUSION

The foregoing is submitted as a full and complete Response to the OA. With consideration of the above amendments and remarks, the undersigned submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned, in person or over the telephone, we would welcome the opportunity to do so.

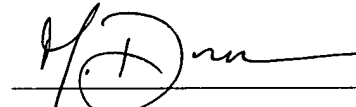
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Respectfully submitted,

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